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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: DaCosta	)	Art Unit; 2614
	)	
Serial No.: 10/782,265	)	Examiner: Beliveau
	)	
Filed: February 19, 2004	)	50T5776
	)	
For: SYSTEM AND METHOD FOR PROVIDING	)	April 5, 2006
CONTENT LIST IN RESPONSE TO SELECTED	)	750 B STREET, Suite 3120
CLOSED CAPTION WORD	)	San Diego, CA 92101
	)	

APPEAL BRIEF

Commissioner of Patents and Trademarks

Dear Sir:

This brief is submitted under 35 U.S.C. §134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 69 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal filed herewith.

Table of Contents

<u>Section</u>	<u>Title</u>	<u>Page</u>
(1)	Real Party in Interest.....	2
(2)	Related Appeals/Interferences.....	2
(3)	Status of Claims.....	2
(4)	Status of Amendments.....	2
(5)	Concise Explanation of Subject Matter in Each Independent Claim.	2
(6)	Grounds of Rejection to be Reviewed.....	3
(7)	Argument.....	4
App.A	Appealed Claims	
App.B	Evidence Appendix	
App.C	Related Proceedings Appendix	

1168-117.API

**CASE NO.: 50T5776**  
**Serial No.: 10/782,265**  
**April 5, 2006**  
**Page 2**

**PATENT**  
**Filed: February 19, 2004**

**(1) Real Party in Interest**

The real parties in interest are Sony Corp. and Sony Electronics, Inc.

**(2) Related Appeals/Interferences**

No other appeals or interferences exist which relate to the present application or appeal.

**(3) Status of Claims**

Claims 1-17 are pending and finally rejected, which rejections are appealed, and Claims 18-27 have been canceled.

**(4) Status of Amendments**

No amendments are outstanding.

**(5) Concise Explanation of Subject Matter in Each Independent Claim, with Page and Figure Nos.**

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

1168-117.AP1

CASE NO.: 50T5776  
Serial No.: 10/782,265  
April 5, 2006  
Page 3

PATENT  
Filed: February 19, 2004

Claim 1 recites a method for obtaining information based on a TV program that includes receiving from a head end transmitter (reference numeral 16, figure 1; page 4, first full paragraph and page 6, first five lines), along with the program, closed captioning text, reference numeral 36, figure 1, page 5, second full paragraph, with primary words within the closed captioning text appearing differently in the closed captioning text than remaining secondary words when the closed captioning text is presented on a display of a TV prior to any user selection of words in the closed captioning text, id. The method also includes permitting a user of a remote control device (12, figure 1, page 4, line 4) communicating with the TV to select at least one word to establish a selected word, figure 2, page 5, last three lines. If the selected word is a primary word, a list of content related to the selected word is displayed, figure 2, block 46, page 6, last four lines.

Claim 10 sets forth a system for obtaining information using a TV closed caption display that includes a TV (11, figure 1, page 4, line 4) receiving content from a source, with the content including closed caption text, supra. A remote control device, supra, is configured for wireless communication with the TV. A data structure (page 6, second full paragraph) is accessible to a computer (e.g., 18 or 26, figure 1, page 4, last paragraph) that is associated with the source and/or the TV, and the computer retrieves from the data structure a list of content related to at least one word appearing in the closed caption text and selected by a user manipulating the remote control device. The word appears within the closed caption text and is selected from the closed caption text by means of the remote control device, supra. The word is made to flash within the closed caption text, page 5, line 17.

**(6) Grounds of Rejection to be Reviewed on Appeal**

1168-117.API

CASE NO.: 50T5776  
Serial No.: 10/782,265  
April 5, 2006  
Page 4

PATENT  
Filed: February 19, 2004

(a) Claims 1, 2, 5, 6, and 8 have been rejected under 35 U.S.C. §103 as being unpatentable over Wasilewski et al., USPN 5,359,601 in view of Isoe et al., USPN 5,671,019 and Brodsky, USPN 5,809,471.

(b) Claim 3 has been rejected under 35 U.S.C. §103 as being unpatentable over Wasilewski et al. in view of Isoe et al., Brodsky, and Sampsell, USPN 6,496,122.

(c) Claim 4 has been rejected under 35 U.S.C. §103 as being unpatentable over Wasilewski et al. in view of Isoe et al., Brodsky, and Chang, USPN 5,543,851.

(d) Claims 7 and 9 have been rejected under 35 U.S.C. §103 as being unpatentable over Wasilewski et al. in view of Isoe et al., Brodsky, and an online dictionary.

(e) Claims 10, 14, and 16 have been rejected under 35 U.S.C. §103 as being unpatentable over Thomsen, USPP 2002/00067428 in view of an IBM Technical Bulletin.

(f) Claim 11 has been rejected under 35 U.S.C. §103 as being unpatentable over Thomsen in view of the IBM Technical Bulletin and Patterson, USPN 5,923,379.

(g) Claim 12 has been rejected under 35 U.S.C. §103 as being unpatentable over Thomsen in view of the IBM Technical Bulletin and Allport, USPN 6,097,441.

(h) Claim 13 has been rejected under 35 U.S.C. §103 as being unpatentable over Thomsen in view of the IBM Technical Bulletin and the online dictionary.

(i) Claim 17 has been rejected under 35 U.S.C. §103 as being unpatentable over Thomsen in view of the IBM Technical Bulletin and O'Brien et al., USPN 6,055,569.

1168-117.API

CASE NO.: 50T5776  
Serial No.: 10/782,265  
April 5, 2006  
Page 5

PATENT  
Filed: February 19, 2004

(7) Argument

In the present rejections, it will not escape the Board's attention that *eleven* references have been used against two independent claims and seventeen claims total in *nine distinct* rejections. Appellant is mindful that obviousness cannot be defeated by the sheer number of references used, but the use of eleven references in nine separate combinations, each one of which is supposed to find a motivation in the prior art, is also a pretty sure signal that hindsight is probably going on somewhere, and indeed it is, as explained more fully below.

(a) Wasilewski et al. has been used as a teaching of a head end that combines closed captioning (CC) with TV signals. Isoe et al. has been used as a teaching of displaying CC with TV programming, and also as a teaching of picture-in-picture (PIP) technology. As readily admitted by the examiner, the proposed combination of these first two references fail to suggest the nut of Claim 1 (per the examiner, "to retrieve supplemental content"). Thus, the first two references have been used as nothing more than a showing that in essence both CC and PIP technology are known.

This admitted gaping shortfall that still remains from the first two references is sought to be alleviated by Brodsky. Here the rejection falls apart on a number of levels, each one of which will now be discussed in turn.

In Brodsky, none of the words within the closed captioning text of Brodsky appear differently from any others, much less are differently appearing words received from the head end transmitter. Instead, in Brodsky, words are added to a dynamically evolving dictionary, and a user later can speak words that are matched to words in the dictionary for obtaining additional content. While the words that are added to the dictionary are

1168-117.API

CASE NO.: 50T5776  
Serial No.: 10/782,265  
April 5, 2006  
Page 6

PATENT  
Filed: February 19, 2004

contained in televised content, they are automatically added to the dictionary by the software *and cannot be selected from the closed captioning text itself*. According to Brodsky, a user subsequently selects words in the dictionary by speaking the words or by selecting words from a menu, but not by selecting words *from* the closed captioning itself. There is simply no suggestion in any reference to allow a user to select a word from closed captioning text to access additional content that is related to the broadcast. There is thus no reason in Brodsky to make words within closed captioning text itself appear differently from other words, as set forth in, e.g., Claim 1, because the words in Brodsky are not selected by a human for addition to the dictionary but by a machine instead.

At this point the Board might be curious as to the nature of the word gaming that plainly must be getting employed to deny a patent. Appellant will divulge it. It is the examiner's position in the body of the rejection on pages 6 and 7 that "primary" words in Brodsky are those in the dictionary, and that the dictionary words can be presented in Isoc's PIP apart from CC and, hence, "appear differently" from secondary words, presumably the words in the CC. Because of the evident weakness in this confusing semantic game (note that Claim 1 requires primary words *within the closed captioning text as received from the head end transmitter* to appear differently *within the closed captioning text* than remaining secondary words when the closed captioning text is presented on a display of a TV), at the bottom of page 7 an "alternative" word game is proposed. The alternative word game is even sillier: it amounts to noting that because the word "cat" looks different than the word "dog", then Brodsky *ipso facto* teaches that some words in the closed captioning text that appear differently than other words.

1168-117.AP1

CASE NO.: 50T5776  
Serial No.: 10/782,265  
April 5, 2006  
Page 7

PATENT  
Filed: February 19, 2004

Not only is this fatuous, it is legal defective. By so interpreting "primary" and "secondary" words, the examiner effectively reads the limitation out of the claim, because under the examiner's interpretation every CC is rendered into a CC having "differently appearing" primary and secondary words. It is a canon of claim construction, however, that every claim term is presumed to have a limiting meaning, Innova/Pure Water Inc. v. Safari Water Filter Systems Inc., 381 F.3d 1111 (Fed. Cir. 2004); indeed, all limitations are material, Glaxo, Inc. v. Novapharm, Ltd., 110 F.3d 1562 (Fed. Cir. 1997). The semantics being employed to reject Claim 1 are thus contrary to law.

Continuing to deconstruct the rejection, while limitations from the specification are not be read into the claims, claims must be construed in light of the specification, Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Indeed, "claims must be interpreted in light of the written description *and not beyond it*", Lizardtech, Inc. v. Regents of the Univ. of California, precedential case no. 05-1062 (in denial of motion to rehear the case *en banc*). Here, the specification clarifies what the examiner would cloud: primary words are taught to "appear differently" not by the banality of merely being a different word but by being underlined, italicized, bolded, having a different font size or color, or by flashing.

It gets worse for the rejection. Claim 1 does not merely recite "primary words" and "secondary words" in a vacuum. Instead, it recites that, if the selected word is a primary word, a list of content related to the selected word is displayed. Under the examiner's overly broad construction, however, since every word appears differently than every other word in CC, every word is a "primary word" that must pass the test of Claim 1, and in the combined references this fails to obtain. Only select words are in Brodsky's dictionary. Many other words - all of them "primary words" under the proffered construction - do not, thus, if selected,

1168-117.AP1

CASE NO.: 50T5776  
Serial No.: 10/782,265  
April 5, 2006  
Page 8

PATENT  
Filed: February 19, 2004

failing to satisfy Claim 1. Consequently, even under the too-clever-by-half construction of Claim 1, the references, combined as proposed, fail to meet Claim 1.

Perhaps sensing the bankruptcy of the logic exposed above, the examiner has felt compelled to offer still further rationalization for his refusal to grant a patent on pages 2-4 of the Office Action, in essence denying that the specification provides no explicit definition of "appearing differently." That is true; it also does not change the law that regardless of whether an explicit definition is provided, the claims must be interpreted in light of the specification. While Appellant has characterized as "non-limiting" whether a word is underlined or bolded, a plain reading of the specification in full context makes clear that Appellant never intended the insipid meaning that every word in the universe is a differently-appearing "primary word" simply because it is spelled differently than every other word. In context, it is plain that the specification regarded as "non-limiting" the peculiar way a primary word was displayed differently from a secondary word, not that all words could be considered to "appear differently" than all other words by virtue of being different words. That senseless meaning would defeat the purpose of the invention, because how would the user know which word might be a primary word to select for more information?

The examiner has taken the trouble to draw a little figure, claiming that the figure is "provided by" the references in combination. Regardless of the interesting puzzle that flows from his discussion of his own figure, what is germane is that the figure is not in the cited references. Like Athena from the mind of Zeus, it springs full-grown from the examiner's imagination. The examiner's imagination is not part of the prior art.

1168-117.AP1



CASE NO.: 50T5776  
Serial No.: 10/782,265  
April 5, 2006  
Page 9

PATENT  
Filed: February 19, 2004

The rejections are thus based on illegitimately broad claim constructions coupled with conjectures, guesses, and extensions to what the relied-upon references actually teach. Rejections such as these are ripe for reversal.

In addition to the above points, Claim 2 is further patentable because its list - of content related to the selected primary word - is different than the relied-upon list in Brodsky, which are the relied-upon primary words themselves.

In addition to the above points, Claim 5 is further patentable because its list from which the user can select a topic is a list of content related to the selected primary word, not the list of relied-upon primary words in Brodsky.

(b) In addition to the above points, Claim 3 is further patentable for the following reasons. Combining Sampsell with the above three references would not result in Claim 3, but rather in what Sampsell actually teaches, namely, displaying TV images on a remote control device. There is no suggestion in Brodsky to display anything on a remote control device, and there is no suggestion in Sampsell to display a list of anything, much less of content related to a selected word, on its remote control. Here is a classic example of hindsight picking and choosing among disparate references to arrive at a claim that under the law should be patentable.

(c) In addition to the above points, Claim 4 is further patentable for the following reasons. Combining Chang with the above three references would not result in Claim 4 but rather in what Chang actually teaches,

1168-117.AP1

CASE NO.: 50T5776  
Serial No.: 10/782,265  
April 5, 2006  
Page 10

PATENT  
Filed: February 19, 2004

namely, providing dictionary definitions of any word the user might happen to select, as opposed to secondary words.

(d) In addition to the above points, Claims 7 and 9 are further patentable for the following reasons. Applicant is not claiming the use of an online encyclopedia in a vacuum, but rather in a new and unsuggested way. Accordingly, simply citing an online encyclopedia essentially for the proposition that because it exists, it would have been obvious to use it in the novel and unsuggested way recited in claims rejected in this section, runs afoul of the requirement that not only must every element be found in the prior art to reject a claim, but also the requisite prior art motivation to modify references to arrive at a claim must be identified, or the *prima facie* case falls.

(e) Now turning to independent Claim 10, nothing in Thomsen teaches or suggests allowing the head end provider to direct attention to provider-selected primary words that, e.g., might happen to link to ancillary content associated with the provider. Indeed, the rejection admits as much, stating that Thomsen fails to teach flashing words in the closed captioning text and thus turning to the IBM Technical Bulletin for succor, which teaches flashing a word in the CC to reflect a speaker's emotion.

If possible, the case for reversal here is even more compelling than the rejections discussed above. There is no motivation in Thomsen to cause any word to appear differently from any other word in the CC that is received from the head end, since Thomsen accepts a user selection of any word and then searches for related content, in effect decoupling content provider control of user selections. The only thing that the

1168-117.AP1

CASE NO.: 50T5776  
Serial No.: 10/782,265  
April 5, 2006  
Page 11

PATENT  
Filed: February 19, 2004

secondary reference motivates is to flash words based on emotion, and has nothing to do with selecting words, much less indicating primary words for selection. Thus, the proposed combination would not arrive at Claim 10, which requires the flashing word to be selected from the closed caption text to retrieve a list of content related to the word. Instead, Thomsen would work just as taught by Thomsen with flashing CC words indicating not primary words for selection of supplemental information but for indicating a speaker's emotion, uncoupled from any supplemental information, as taught by the secondary reference. A clearer example of hindsight reconstruction made possible only by reading a claim sought to be rejected would be difficult to find.

(f) In addition to the above points, Claim 11 is further patentable for the following reasons. Claim 11 requires a list of content to be displayed in a PIP, whereas in the relied-upon portion of Patterson a Web page only is displayed in a PIP. A Web page is not a list. Since Thomsen has not been used to teach PIPs, and since Patterson teaches displaying only Web pages, not lists, the proposed combination would not reach Claim 11.

(g) In addition to the above points, Claim 12 is further patentable for the following reasons. Claim 12 requires a list of content related to a selected word to be displayed on a remote control device, whereas in the relied-upon portions of Allport a Web page only is displayed on a remote. A Web page is not a list. Since Thomsen has not been used to teach displaying anything on remotes, and since Allport teaches displaying only Web pages, not lists, the proposed combination would not reach Claim 12.

(h) In addition to the above points, Claim 13 is further patentable for the following reasons. Applicant is not claiming the use of an online encyclopedia in a vacuum, but rather in a new and unsuggested way.

1168-117.AP1

CASE NO.: 50T5776  
Serial No.: 10/782,265  
April 5, 2006  
Page 12

PATENT  
Filed: February 19, 2004

Accordingly, simply citing an online encyclopedia essentially for the proposition that because it exists, it would have been obvious to use it in the novel and unsuggested way recited in claims rejected in this section, runs afoul of the requirement that not only must every element be found in the prior art to reject a claim, but also the requisite prior art motivation to modify references to arrive at a claim must be identified, or the *prima facie* case falls.

(i) In addition to the above points, Claim 17 is further patentable for the following reasons. In the cited three columns of O'Brien et al., there is some hazy correlating going on, but nowhere in the pointed-to columns does O'Brien appear to teach or suggest adding content to a local data storage associated with the TV and correlating the content with other content related to the selected word. Thus, the proposed combination would not reach Claim 17.

Respectfully submitted,

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John L. Rogitz  
Registration No. 33,549  
Attorney of Record  
750 B Street, Suite 3120  
San Diego, CA 92101  
Telephone: (619) 338-8075

JLR:jg

1168-117.AP1

CASE NO.: 50T5776  
Serial No.: 10/782,265  
April 5, 2006  
Page 13

PATENT  
Filed: February 19, 2004

#### APPENDIX A - APPEALED CLAIMS

1. A method for obtaining information based on a TV program, comprising:  
receiving from a head end transmitter, along with the program, closed captioning text;  
primary words within the closed captioning text as received from the head end transmitter appearing differently within the closed captioning text than remaining secondary words when the closed captioning text is presented on a display of a TV prior to any user selection of words in the closed captioning text;  
permitting a user of a remote control device communicating with the TV to select at least one word to establish a selected word; and  
if the selected word is a primary word, displaying a list of content related to the selected word.
2. The method of Claim 1, wherein the list is displayed in a picture-in-picture (PIP) window on the TV.
3. The method of Claim 1, wherein the list is displayed on a display of the remote control device.
4. The method of Claim 1, wherein the selected word is a secondary word, and the method comprises displaying a dictionary definition of the selected word.

1100-117,API

CASE NO.: 50T5776  
Serial No.: 10/782,265  
April 5, 2006  
Page 14

PATENT  
Filed: February 19, 2004

5. The method of Claim 1, further comprising permitting a user to select at least one content on the list and displaying the content.
6. The method of Claim 5, wherein the content is obtained from an audio/video data storage associated with the TV.
7. The method of Claim 5, wherein the content is downloaded from at least one of: the Internet, and a transmitter head end, in response to the user selecting the content.
8. The method of Claim 7, further comprising adding the content to a local data storage associated with the TV and correlating the content with other content related to the selected word.
9. The method of Claim 7, further comprising billing the user for downloading the content.
10. A system for obtaining information using a TV closed caption display, comprising:
  - a TV receiving content from a source, the content including closed caption text;
  - a remote control device configured for wireless communication with the TV; and
  - a data structure accessible to a computer associated with at least one of: the source, and the TV, the computer retrieving from the data structure a list of content related to at least one word appearing in the closed caption text and selected by a user manipulating the remote control device, the

1168-117.AP1

CASE NO.: 50T5776  
Serial No.: 10/782,265  
April 5, 2006  
Page 15

PATENT  
Filed: February 19, 2004

word appearing within the closed caption text and being selected from the closed caption text by means of the remote control device, the word being made to flash within the closed caption text.

11. The system of Claim 10, wherein the list is displayed in a picture-in-picture (PIP) window on the TV.

12. The system of Claim 10, wherein the list is displayed on a display of the remote control device.

13. The system of Claim 10, wherein the user can select a word to cause the computer to transmit to the TV a dictionary definition of the word.

14. The system of Claim 10, wherein the remote control device can be manipulated to select at least one content on the list for displaying the content.

15. The system of Claim 14, wherein the content is obtained from an audio/video data storage associated with the TV, and the computer is in the TV.

16. The system of Claim 14, wherein the content is downloaded from at least one of: the Internet, and a transmitter head end, in response to the user selecting the content.

1168-117.AP1

**CASE NO.: 50T5776**  
**Serial No.: 10/782,265**  
**April 5, 2006**  
**Page 16**

**PATENT**  
**Filed: February 19, 2004**

17. The system of Claim 16, wherein a processor associated with the TV adds the content to a local data storage associated with the TV and correlates the content with other content related to the selected word.

1168-117.API



**CASE NO.: 50T5776**  
**Serial No.: 10/782,265**  
**April 5, 2006**  
**Page 17**

**PATENT**  
**Filed: February 19, 2004**

**APPENDIX B - EVIDENCE**

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

1168-117.AP1

CASE NO.: 50T5776  
Serial No.: 10/782,265  
April 5, 2006  
Page 18

PATENT  
Filed: February 19, 2004

**APPENDIX C - RELATED PROCEEDINGS**

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

1164-117.API